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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/604,953	08/28/2003	Shaun Wright		1952

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THE LAW OFFICE OF ROBERT R. WARD, JR., ESQ.
8170 SW 93RD AVE
MIAMI, FL 33173

EXAMINER

CHAMBERS, TRAVIS SLOAN

ART UNIT	PAPER NUMBER
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2833

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/10/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

7H

Office Action Summary	Application No. 10/604,953	Applicant(s) WRIGHT, SHAUN	
	Examiner Travis Chambers	Art Unit 2833	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08/28/2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>08/28/2003</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, 5, 7, 9 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by G. Gonzalez (1690860).

In reference to claim 1, Gonzalez teaches a globular shaped body (10 ; figure 1) made entirely from material designed to illicit specific sounds when placed in contact with one or more strings of a stringed musical instrument having a tapered inner surface (near lead line 10 ; figure 2) means to receive a musician's finger, an inner end having a hole (near lead line 13 ; figure 2) adapted to receive a musician's finger, a closed outer end (top portion 10 ; figure 2), and an outer surface for contacting strings of a stringed musical instrument encompassing said closed outer end (top portion 10), a finger ring (15 ; figure 2) and a means connecting the globular body (10) to the finger ring (15) allowing a musician's finger to bend normally.

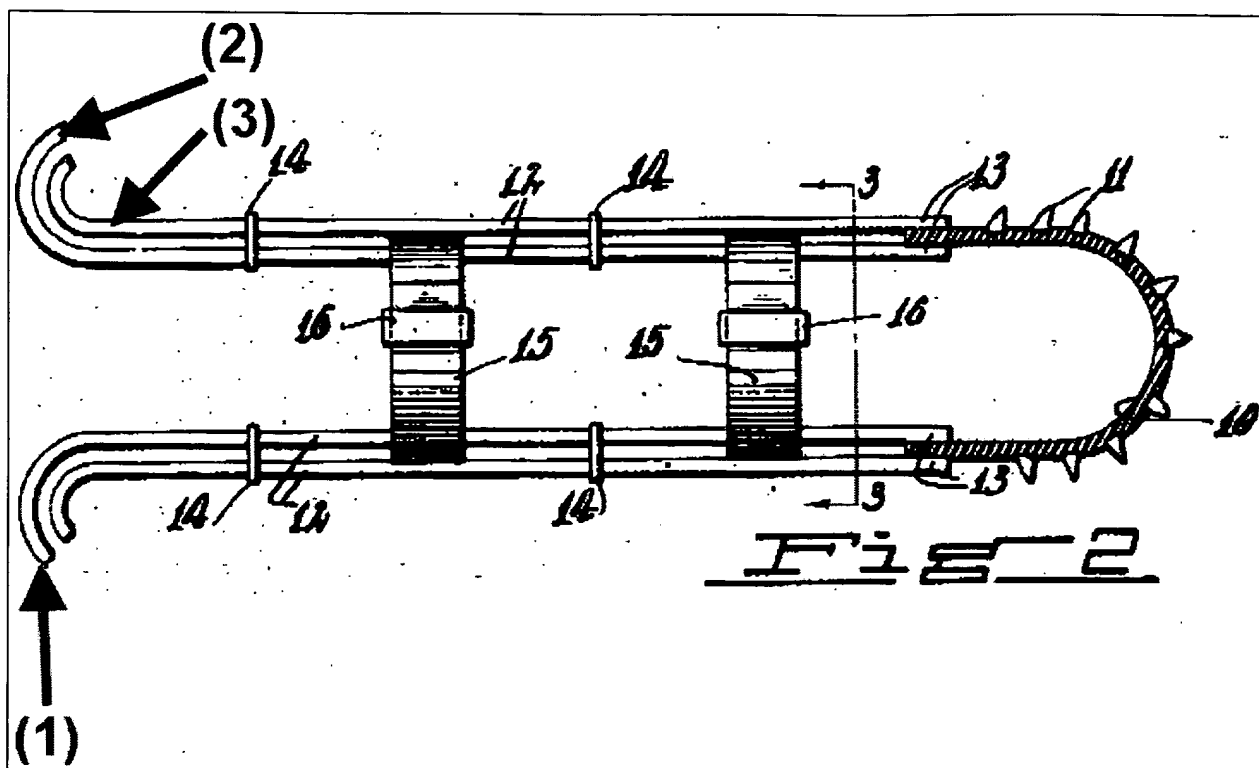
Herein, in particular reference to the recitation "designed to illicit", this is seen to be for the intended use of the claimed structure and are given little patentable weight.

Further, the recitation is not seen to claim any structure that prevents the reference from being used for the same purpose as the intended use recitation of the claim.

In reference to claim 3, Gonzalez teaches a tapered cylindrical shaped body (10 ; figure 1) made entirely from material designed to illicit specific sounds when placed in contact with one or more instrument having a tapered inner surface (near lead line 10 ; figure 2) means to receive a musician's finger, an inner end having a hole (near lead line 13 ; figure 2) adapted to receive a musician's finger, a closed outer (top portion 10 ; figure 2) end extending beyond the musician's finger, and an outer surface for contacting strings of a stringed musical instrument encompassing the closed outer end (top portion 10), a finger ring (15 ; figure 1) and ;a means connecting the cylindrical shaped body (10) to the finger ring (15) allowing a musician's finger to bend normally.

In reference to claims 5 and 7, Gonzalez teaches where the means to connect the finger ring (15) and the globular body (10) are at least two semi-rigid strips (1,2 ;image below .

In reference to claims 9 and 11, Gonzalez teaches where the means to connect the finger ring (15) and the globular body (10) are three semi-rigid strips (1,2,3 ; image below).



Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 13,15 are rejected under 35 U.S.C. 103(a) as being unpatentable over G.

Gonzalez (1690860) in view of R.F. Richards (D031151).

In reference to claims 13 and 15, Gonzalez shows substantially the invention as claimed.

However Gonzalez does not teach the means to connect the finger ring and the globular body is a single semi-rigid strip.

It is known in the art of omission of elements to omit a semi-rigid strip to have a single semi-rigid strip. Richards is an example that teaches of a single semi-rigid strip.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to omit a semi-rigid strip, since it has been held that omission of an element and its function in a combination where the remaining elements perform the same function as before involves only routine skill in the art. In re Karlson, 136 USPQ 184.

One skilled in the art would have been motivated to choose such an element to omit to make it marketable to consumers that desire the advantages, reliability or performance associated with the particular omission.

Claims 2, 4,6,8,10,12 are rejected under 35 U.S.C. 103(a) as being unpatentable over G. Gonzalez (1690860) in view of C.E. Jones (2717799).

In reference to claims 2 and 4, Gonzalez shows substantially the invention as claimed.

However Gonzalez does not teach a groove present transversely across the outer surface to facilitate contact with a single string of a stringed musical instrument.

It is known in the art to change the shape of the outer surface so it can have a groove. Jones is an example that teaches of a groove (between 5 ; figure 2) present transversely across the outer surface (3 ; figure 1).

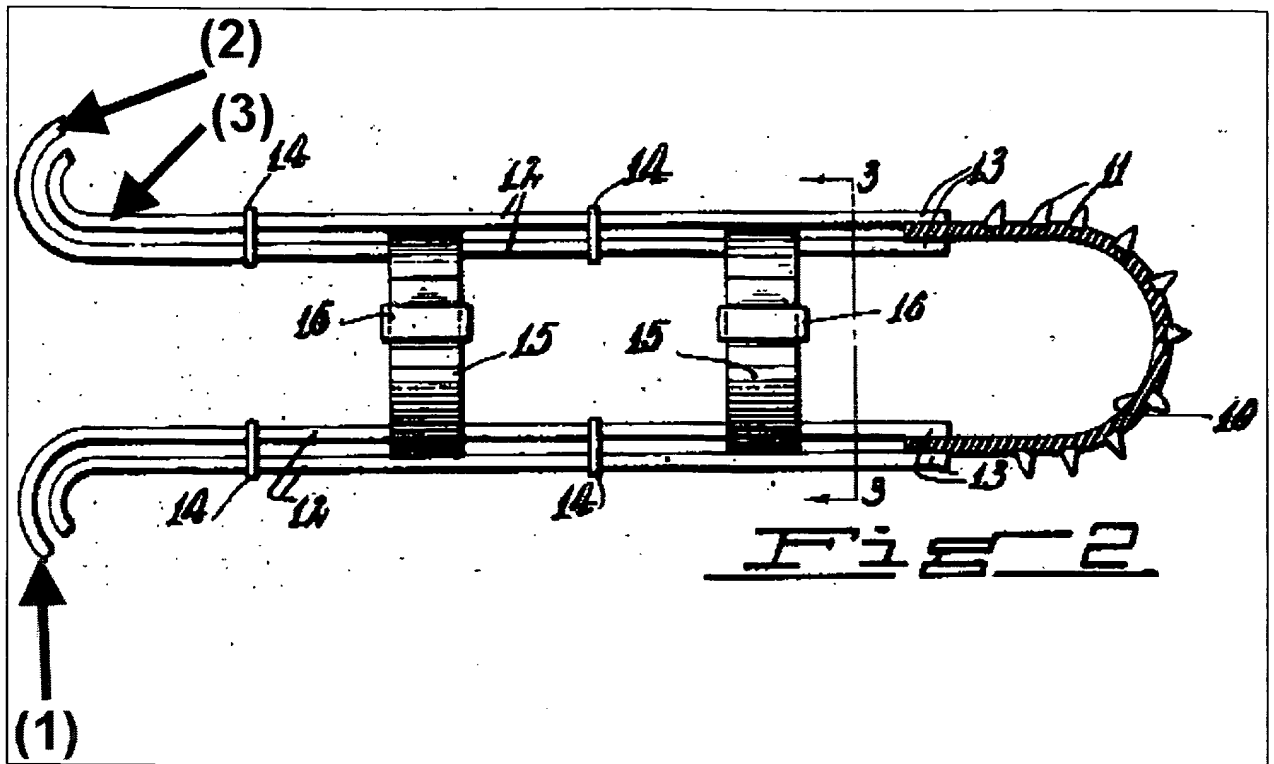
It would have been obvious at the time of the claimed invention to change the shape of the outer surface, since such a modification would have involved a mere change in the shape of a component. A change in shape is generally recognized as being within the level of ordinary skill in the art. In re Rose, 105 USPQ 237 and (CCPA 1955), In re Dailey, 149 USPQ 47 (CCPA 1976).

One skill in the art would have been motivated to select the shape based on aesthetic/environmental requirements/preference that are driven by a desire to increase market share.

In particular reference to the recitation "to facilitate contact"; this is seen to be for the intended use of the claimed structure and are given little patentable weight. Further, the recitation is not seen to claim any structure that prevents the reference from being used for the same purpose as the intended use recitation of the claim.

In reference to claims 6 and 8, Gonzalez teaches where the means to connect the finger ring (15) and the globular body (10) are at least two semi-rigid strips (1,2 ; image below) .

In reference to claims 10 and 12, Gonzalez teaches where the means to connect the finger ring (15) and the globular body (10) are three semi-rigid strips (1,2,3; image below).



Claims 14 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over G. Gonzalez (1690860) in view of C.E. Jones (2717799) further in view of R.F. Richards (D031151).

In reference to claims 14 and 16, Gonzalez shows substantially the invention as claimed.

However Gonzalez does not teach the means to connect the finger ring and the globular body is a single semi-rigid strip.

It is known in the art of omission of elements to omit a semi-rigid strip to have a single semi-rigid strip. Richards is an example that teaches of a single semi-rigid strip.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to omit a semi-rigid strip, since it has been held that omission of an

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element and its function in a combination where the remaining elements perform the same function as before involves only routine skill in the art. In re Karlson, 136 USPQ 184.

One skilled in the art would have been motivated to choose such an element to omit to make it marketable to consumers that desire the advantages, reliability or performance associated with the particular omission.

Conclusion

The prior listed on PTO form 892 that is made of record is considered pertinent to applicant's disclosure because it shows the state of the art with respect to applicant's claimed invention.

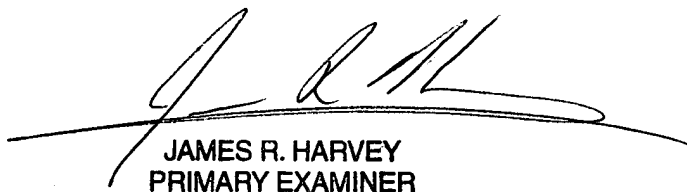
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Travis Chambers whose telephone number is 571-272-6813. The examiner can normally be reached on Monday-Friday 8am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula Bradley can be reached on 571-272-2001. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Travis Chambers
TC
3/27/2007



JAMES R. HARVEY
PRIMARY EXAMINER